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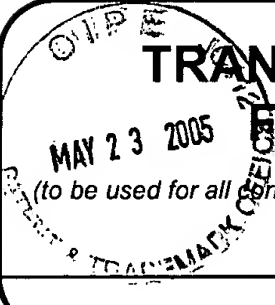
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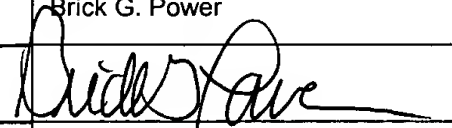
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 TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/928,314
	Filing Date	August 13, 2001
	First Named Inventor	Tim J. Corbett
	Group Art Unit	2823
	Examiner Name	G. Fourson, III
Attorney Docket Number		2269-2688.5US (93-0318.08/US)

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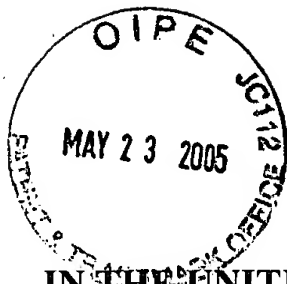
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Date	May 23, 2005	

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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Tim J. Corbett

Serial No.: 09/928,314

Filed: August 13, 2001

For: LASER MARKING TECHNIQUES

Confirmation No.: 7920

Examiner: G. Fourson, III

Group Art Unit: 2823

Attorney Docket No.: 2269-2688.5US

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REPLY BRIEF

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Attn: Board of Patent Appeals and Interferences

Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated March 23, 2005, and in accordance with 37 C.F.R. §§ 1.193(b)(1) and 41.71(a).

(2) RELATED APPEALS AND INTERFERENCES

The final rejections that were made in 10/137,586, which is related to the above-referenced application, are now subject to an appeal before the Board, and could have some affect or be affected by the Board's decision in the above-referenced appeal.

(8) ARGUMENT

Claims 1-18 have been rejected under 35 U.S.C. § 103(a) for reciting subject matter that is allegedly unpatentable over the subject matter taught in U.S. Patent 4,594,263 to Folk (hereinafter "Folk"), in view of teachings from U.S. Patent 5,757,313 to Meneghini et al. (hereinafter "Meneghini").

Claims 19-23 stand rejected under 35 U.S.C. § 103(a) for being drawn to subject matter which is assertedly obvious over that taught in Folk, in view of the teachings of Meneghini and, further, in view of teachings from U.S. Patent 5,256,578 to Corley et al. (hereinafter "Corley") and some purportedly admitted prior art..

The Office has cited a Federal Circuit opinion, *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 17 USPQ2d 1516, 1522-23 (Fed. Cir. 1998), to indicate that a reference that teaches away from claimed subject matter may still anticipate the claimed subject matter. The law at issue in that case was 35 U.S.C. § 102. The court's holding is wholly inapplicable to rejection under 35 U.S.C. § 103(a), the only legal ground for rejection that has been made and maintained in the above-referenced application.

When rejecting claims under 35 U.S.C. § 103(a), a reference that teaches away from claimed subject matter or a combination of reference teachings that has been asserted by the

Office cannot be relied upon to establish a *prima facie* case of obviousness under 35 U.S.C.

§ 103. M.P.E.P. §§ 2141.02, 2143.01.

Folk teaches a process for marking semiconductor devices that have been packaged in metal. The process of Folk includes cleaning the surface of the metal package, using electroless plating techniques to form a nickel layer thereon, cleaning residual salts from the metal package and the nickel layer, and exposing the nickel to acid to convert it to an optically black form which is highly absorptive of laser energy. When marking is desired, such as when a semiconductor device package has been tested and it is determined that the semiconductor device is suitable for use, selected locations of the optically black coating on the nickel layer may be exposed to a laser to expose the underlying, shiny nickel at those locations, thereby forming a mark on the metal semiconductor device package.

Folk also teaches that these processes are far superior to the use of inks or other similar materials that must be cured, as such materials undesirably “involve several stages of handling” and results in marks that “may be removed by abrasion.” Col. 1, lines 28-30.

Menghini teaches that inks may be applied to various types of substrates, including microelectronic devices (col. 1, lines 12-15) and cured by laser irradiation. *Id.*

Corley teaches a process in which devices that have yet to be singulated from a wafer are tested, bad devices are identified, and mapping information is laser scribed in binary code onto an “inactive” region of the wafer.

It has been asserted that the “Background” section of the above-referenced application (the Purportedly Admitted Prior Art) teaches that semiconductor devices may be improperly marked or illegibly marked.

It is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) cannot be established against any of claims 1-27 based on any combination of the teachings of Folk, Menghini, Corley, and the Purportedly Admitted Prior Art. This is because at least two of the references teach away from the purported combination of the cited references.

For example, Folk clearly teaches away from the asserted combination of teachings therefrom with ink-marking or polymer-marking teachings such as those of Menghini. Specifically, at col. 1, lines 25-31, Folk teaches that the use of ink and, presumably, other polymers, for marking is undesirable since several stages of handling may be required, cure times are required, and such marks may be removed from substrates.

Corley likewise teaches away from the use of ink dots for identifying semiconductor devices, indicating that the “ink can chemically damage the die or the packaged device” (col. 1, lines 32-34), that the “ink can smear or run from one die to another die” (col. 1, lines 34-35), that the “ink can . . . dry and fall off the die” (col. 1, lines 34-35), the inks are messy (col. 1, lines 40-43), and that the “solvents which must be used to remove the ink” from incorrectly marked semiconductor devices “are hazardous chemicals which are difficult to use and store” (col. 1, lines 37-40).

As Folk and Corley clearly teach away from the asserted combination of their teachings with teachings of the type made in Menghini, it is respectfully submitted that the only way that one of ordinary skill in the art would have been motivated to combine the teachings of Folk and Corley with those of Menghini would have been from improper hindsight provided solely by the teachings of the above-referenced application. The Purportedly Admitted Prior Art provides no

teachings that would remedy the fact that Folk and Corley teach away from the combination of their teachings with those of Menghini.

Moreover, it is respectfully submitted that none of Folk, Menghini, Corley, or the Purportedly Admitted Prior Art, taken either collectively in any combination or individually, teaches or suggests "comparing [an] identifying indicia to an identifying indicia model," as required by claim 19. In addition, none of these references teaches or suggests "determining whether [the] identifying indicia substantially matches [the] identifying indicia model," as required by claim 20, which depends from claim 19. Further, none of the cited references teaches or suggests "rejecting" a "semiconductor chip . . . if its respective identifying indicia does not substantially match [the] identifying indicia model," as required by claim 21.

It is, therefore, respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established against any of claims 1-23.

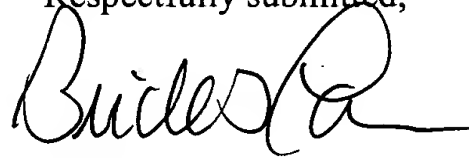
(10) CONCLUSION

It is respectfully submitted that claims 1-18 are nonobvious and, thus, patentable under 35 U.S.C. § 103(a) over the subject matter taught in Folk, in view of teachings from Meneghini, and that claims 19-23 are allowable under 35 U.S.C. § 103(a) for reciting subject matter which is nonobvious over that taught in Folk, in view of the teachings of Meneghini and, further, in view of teachings from Corley.

Serial No. 09/928,314

For these reasons, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 1-23 be reversed and that each of these claims be allowed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brick G. Power", written over the typed name.

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Date: May 23, 2005

BGP/eg

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